

REMARKS

In response to the Office Action mailed November 4, 2004, Applicant amends his application and requests continued examination. In this Amendment, no claims are cancelled and new claims 23-44 are added to the claims 1-44 are now pending.

What is the basis of rejection of claim 16?

In response to the Office Action dated April 26, 2004, Applicant inquired, at pages 6 and 7 of the response filed July 22, 2004, as to the basis of the rejection of claim 16. It could not be determined from the Office Action whether claim 16 was rejected as anticipated by Heidel et al. (U.S. Patent 6,289,261, hereinafter Heidel) or whether claim 16 was rejected as obvious over Heidel in view of the combination of three additionally cited patents. The reason for this inquiry was that page 2 of the Office Action did not state that claim 16 was rejected as anticipated. In paragraph 2 of the Office Action, however, in line 4 of that paragraph, it was stated that claim 16 was rejected as anticipated. At page 4 of the Office Action, on the other hand, it was stated that claim 16 was rejected as obvious. The complex discussion of the obviousness rejections, unlike anything seen in 25 years of practice, at page 5 of the Office Action seems to set a predicate only for the rejection of claim 16 as obvious. This discussion of claim 16 apparently continued at pages 7 and 8 of the Office Action. Further, claims 17-20, claims that ultimately depend from claim 16, were rejected as anticipated by Heidel, not as obvious. That rejection is legally impossible unless claim 16 is rejected as anticipated.

Although this confusion was pointed out in the response filed July 22, 2004, the Examiner provided no reply. Rather, the Official Action mailed November 4, 2004 repeated, *verbatim*, the prior art rejections from the first Office Action, adding only nine lines of explanation as to why the rejections were maintained without alteration. This reply has left the Applicant in a quandary. Important points were raised in the response filed July 22, 2004, and are again raised, with new points, in this response. A thoughtful reply clearly indicating consideration of what is presented here is again requested.

Applicant respectfully requests the clarification of the status of claims 16-20, unless those claims are allowed. In order to effectuate this request, at the end of this Response, Applicant is making a formal request for a personal interview with his Washington-based representative in an attempt to move this prosecution to an early and successful conclusion.

Claim Amendments

Examined independent claims 1 and 16 are amended in the Response. Claim 1 is directed to a currency control system that incorporates three elements: a portable safe, a game-related device, and a currency control device. Claim 1 is clarified by explaining further, although without substantively changing the claim, the interaction between the currency control device and the portable safe, when the portable safe is attached to the currency control device. As previously explained in the claim and is now explained further, the currency control device provides either the transfer of currency from itself into the portable safe when attached to the currency control device or the transfer of currency from the portable safe into the currency control device when the safe is attached to the currency control device. In other words, the currency control device provides at least one of, if not both of, the functions of transferring currency into and from the portable safe. Amended claim 1 further describes the game-related device and the currency control device as being separated from each other, i.e., at remote locations relative to each other. The portable safe is also described as being transportable so that it functions as a carrier of currency between the game-related device and the currency control device. In other words, in the invention, the portable safe can collect currency at a game-related device when attached to that game-related device so that the collections can be transported to the currency control device. Likewise, the currency control device, when it transfers currency into the portable safe, provides that currency for transport to a game-related device, for example, for collecting the cost of a game activating card dispensed to a game player when the portable safe is attached to a machine selling and dispensing such cards.

Claim 16, the second examined independent claim, is directed to the portable safe itself. Claim 16 is amended in the same way that claim 1 is amended to describe the portable safe as providing transportation for currency either in a direction of collection, i.e., from a game-related device to the currency control device, or from the currency control device to the game-related device. Claim 16 is also amended to include a limitation like claim 1 describing the transfer of currency from the currency control device into the portable safe and the transfer of currency from the portable safe into the currency control device, with the portable safe providing at least one, if not both of those functions.

Both of independent claims 1 and 16 are clarified to explain, as was apparent from the examined claims, the relative positions of the currency control device and the game-related device. As understood by those of skill in the art, the currency control device is remote from, i.e., not located adjacent to or at the same position as, the game-related device. This arrangement is a security measure providing for the transfer of currency to and the transfer of

currency from the portable safe at a position that is not accessible by players of the game-related device to avoid theft.

New Claims

In this Amendment new claims 23-44 are added. These claims are derived from original claims 1-22. Claim 23 is analogous to claim 1, in some ways, because it is directed to a currency control system. However, unlike the system of claim 1, the system of claim 23 includes a plurality of the game-related devices and a plurality of the portable safes. The safes are all attachable, interchangeably, one at a time, to each of the game-related devices as well as to the currency control device. In other words, each of the portable safes is universal with respect to the currency control device in each of the game-related devices so that there is no necessity of maintaining a fixed correlation between particular game-related devices and particular safes. Otherwise, claim 23 is similar to claim 1. Dependent claims 24-37 are direct analogs and supported by claims 2-15.

New independent claim 38 is analogous to examined claim 16 but expressly explains that the portable safe is essentially interchangeable with any of a plurality of game-related devices. Both of claims 16 and 38 explain that the housing of the safe includes currency insertion and currency discharging windows and corresponding locking shutters that open and close those windows when the portable safe is attached to one of the game-related devices or to the currency control device. New claims 39-44 are taken from and are supported by original claims 17-22.

Prior Art Rejection—Anticipation

As best understood, claims 1-5, 7, 8, and 16-20 are rejected as anticipated by Heidel. These rejections are incorrect and therefore respectfully traversed. It is assumed that claim 16, for the purposes of this response, is at least rejected as anticipated. If it was intended, in repeating the previous rejections, to reject claim 16 as obvious, the attempt failed in the maintenance of the rejection of claims 17-20, claims that depend from claim 16, as anticipated. In the absence of guidance, sought in a prior inquiry, Applicant treats claim 16 as rejected both as anticipated and as obvious.

From fundamental principles, it is apparent that if a reference fails to disclose all of the elements of an invention claimed, the reference cannot anticipate that claim. Here, with regard to the initial rejection for anticipation, if Heidel fails to anticipate claims 1 and 16 then Heidel cannot anticipate any pending claim. Thus, the following discussion with regard to the

anticipation rejection focuses on claims 1 and 16 and demonstrates that no pending or examined claim has been or is anticipated by Heidel.

Heidel is certainly pertinent prior art. Heidel describes an apparatus, curiously referred to as a hopper 16, that is attached to a slot machine and that includes a cassette 18 that is removably attachable to the hopper. The function of the hopper is to dispense “paper tokens”, paper money, to a player who wins a prize while operating the slot machine. As shown in Figure 1 of Heidel, the hopper has nothing to do with collecting the price for playing the slot machine. Rather, a coin or token is inserted in a slot 26 in order to play the machine. The function of the hopper is to dispense the currency that has been loaded into the cassette 18 as a cash prize. The cassette 18 is removable so that it can be taken to a cash loading station for the purposes of both accounting reconciliations with regard to the dispensed currency and manual reloading of currency into the cassette. Much of Heidel is directed to the mechanical structure that provides for dispensing currency from the cassette through the slot 36 in the hopper.

With regard to amended claims 1 and 16, it is clearly impossible for Heidel to describe, in any of its elements, anything corresponding to the portable safe and the currency control device as defined by those claims. Amended claims 1 and 16 specify that the currency control device is located at a position remote from the game-related device. No one can reasonably assert, after studying Figures 1 and 10 of Heidel, that the hopper 16 is remotely located from the Heidel slot machine 14. Moreover, the amended claims state that the portable safe is transportable between the game-related device and the currency control device. Again, it is impossible to consider that the Heidel cassette 18 is transportable between the Heidel slot machine 14 and the hopper 16 for any useful purpose because the hopper is attached to the slot machine and the slot machine has no interaction with the cassette 18 except through the hopper 16. Applicant agrees that the cassette 18 of Heidel is transportable between the slot machine 14 and a docking station, including a housing 100, at a remote location. However, as explained below, that housing 100 cannot correspond to the currency control device of the invention because it does not provide for either transferring currency into or from the portable safe.

Figure 10 is the only figure of Heidel that shows the remote location where the accounting function can take place. There, a cassette 18, retrieved from a hopper attached to a slot machine, is inserted into the housing 100 of the docking station. The docking station provides an electrical interconnection to a computer for obtaining information on the quantity on the currency dispensed, including currency that was unsuccessfully attempted to be dispensed and was retained in a separate part of the cassette.

The Examiner’s attention is directed to Figures 4 and 10 of Heidel, taken in combination. Figure 4 shows that in order to load the cassette 18 with currency, the hinged lid of the cassette

must be opened. When the cassette 18 is inserted into the housing 100 of the docking station, it is impossible to open the cassette 18 as shown in Figure 4. In other words, it is physically impossible for the docking station, if compared to the currency control device of the present invention, to transfer currency into the cassette 18 or transfer currency out of the cassette 18 because the cassette is completely closed and cannot be opened when attached to the docking station.

In summary, the hopper, cassette, and slot machine of Heidel cannot be properly compared to the currency control device, the portable safe, and the game-related device of the invention to establish anticipation. The hopper and game-related device of Heidel are never remotely located from each other as are the currency control device and the game-related device of the invention. Moreover, Heidel's docking station could not correspond to the currency control device because there is no possibility of transferring currency between the docking station and the Heidel cassette. Because of the differences enumerated here, Heidel cannot anticipate any pending claim.

Prior Art Rejections-Obviousness

The rejections for obviousness made in the previous Official Action remain difficult to parse and are not properly correlated with the dependency relationships of the claims rejected. For that reason, a further explanation of the obviousness rejections is an important agenda item for the interview requested below.

Nominally, there is a blanket rejection of claims 6, 9-16, 21, and 22 as obvious over Heidel in view of Tillim et al (U.S. Patent 6,065,408, hereinafter Tillim), in view of Kaish et al. (U.S. Patent 5,997,928, hereinafter Kaish) and still further in view of Martin et al. (U.S. Patent 6,520,308, hereinafter Martin). This blanket rejection is followed by a complex statement of how each of the references is applied to respective claims. However, the claims to which various of the references allegedly apply are scattered throughout the discussion in the Office Action so that it is nearly impossible to correlate the rejections directly with particular claims.

In an attempt to understand the obviousness rejection, a matrix of the claims rejected, their dependency relationships, and the references mentioned has been prepared. Based upon that matrix, Applicant understands the obvious rejections to be correctly stated as follows and invites the Examiner's comment. Claims 6, 9, and 10 are rejected as obvious over Heidel in view of Tillim. Claims 11, 13, and 14 are rejected as unpatentable over Heidel in view of Kaish and further in view of Tillim. Claims 12 and 15 are rejected as unpatentable over Heidel in view of Kaish. Claims 16, 21, and 22 are rejected as unpatentable over a purported combination of all four of the cited references. Again, if this understanding is incorrect, the Examiner is

respectfully requested to explain the intended obviousness rejections and how the references are allegedly combined to produce the claimed invention.

The simple answer to the rejection of claims 6 and 9-15 as obvious is that those claims cannot be obvious over the asserted combinations of references because those claims depend directly or indirectly from claim 1. Thus, the rejection of each of those claims is based upon the assertion that Heidel anticipates claim 1. For the reasons already provided, that rejection is erroneous so that none of the obviousness rejections of these seven claims can be maintained even if the additionally cited references should disclose elements added to claim 1 by these dependent claims 6 and 9-15.

In making the rejection, the Examiner asserted that Heidel, Tillim, Kaish, and Martin are all "considered to be analogous art" because they all concern currency handling. The necessity of making that statement illustrates the concern that Kaish and Martin are not analogous art because, as discussed below, neither patent is analogous art and neither should ever have been applied in rejecting any claim of this patent application as obvious. On this additional ground, every rejection for obviousness that relies upon Kaish and Martin namely, apparently, the rejections of claims 11-16, 21, and 22, must be withdrawn.

A prior art publication is analogous art and may be applied in a multiple reference obviousness rejection only if the publication is either in the field of the endeavor of the invention or is directed to solving the same problem that is solved by the invention. MPEP 2141.01(a). The field of the invention is clearly control of currency and anti-theft control in gaming and other operations requiring handling of large amounts of cash. The field of Kaish, as stated by Kaish in column 1, is vending apparatus, particularly food vending apparatus that includes an accounting feature. Clearly, the fields of the invention and of Kaish are totally different so that Kaish fails the first of the two tests as analogous prior art.

The problem sought to be solved in the invention is the transfer of currency between a central collecting and disbursing location and the location of a game played by paying cash and providing cash prizes. Further, the invention is directed to providing security against theft at both locations and during transportation between the locations. By contrast, the problem addressed by Kaish is the prevention of contamination or tampering with food, especially kosher food that is supplied in a vending machine. Kaish is particularly directed to maintaining the integrity of the conditions establishing the special kosher quality of the food, so that the kosher status is not compromised in vending the food. Clearly, the problem sought to be solved by Kaish, prevention of tampering with food being vended, is completely different from preventing theft of currency in a gaming operation. Attention is directed to Kaish from column 1, line 43-column 2, line 19 regarding the Kaish problem and its solution and to the distinction of that

objective, in Kaish, from preventing theft of money from a vending machine. This passage unequivocally distinguishes the objective of Kaish from the objective of the invention and shows that Kaish cannot meet the second test required to be analogous art to the claimed invention. Therefore, Kaish must be withdrawn as a reference. Upon the withdrawal of Kaish as a reference, clearly, the rejection of claims 11-16, 21 and 22 as obvious must be withdrawn.

Likewise, Martin is not analogous art to the invention of claim 16 and its dependent claims. The field of the invention of Martin is counting coins or other discrete objects. The whole context of Martin is directed to dealing with such metallic objects and their interactions with electromagnetic fields to detect their passage and characteristics. By contrast, the invention (and Heidel) is expressly directed to the handling of currency, i.e., paper money that is not moved in response to gravity and does not interact with electromagnetic fields to achieve various ends, such as those described by Martin. Thus, Martin fails to fall within the same field as the present invention, which concerns the prevention of currency theft in the handling of currency.

The problem to which Martin attempts to provide a solution relates to the handling of coins and similar objects and that provides increased discrimination between different coins with an apparatus that is cheaper and smaller in size than prior apparatus. See column 3 of Martin. Clearly, this objective is not directed to solving the same problem that is solved in the invention, namely providing anti-theft controls in the handling of large amounts of paper money. Thus, like Kaish, Martin fails both alternatives tests as analogous art. Accordingly, Martin is not analogous art and cannot be properly applied in rejecting any claim as obvious in combination with other publications, such as Heidel and Tillim. For this additional reason, the rejection of claims 16, 21, and 22 as obvious over combinations of references including Martin is erroneous and cannot properly be maintained.

Even if Kaish and Martin were analogous prior art and were properly cited, the Examiner failed to demonstrate *prima facie* obviousness of claim 16 or its dependent claim 21 and 22. Among the features of the portable safe described in claim 16 are the presence of the currency insertion window section and the currency discharging window section. Further, each of these sections includes a respective shutter plate closing the window sections. The Examiner acknowledged that Martin, directed to counting coins, only describes a single gate 17, which the Examiner analogizes to the shutter for the currency inserting window section of claim 16. According to the Office Action at page 8, once the presence of one such shutter plate is known, it would have been obvious to provide a second such plate for a currency discharging window section. Of course, this statement is incorrect because it is unsupported by Martin. No such second gate is present in Martin because no second shutter gate is needed by Martin. Instead, the coins are collected in a hopper and removed in lots, not through a window or a slot, such as

the entrance slot including the gate 17 in Martin. The basis for the rejection is speculation that is not supported by any mechanical element that is either present, suggested, or needed in Martin. Thus, if Martin is analogous art, *prima facie* obviousness of claims 16, 21, and 22 has not been established.

On the same ground, even if an actuating device for the gate 17 in Martin could be considered a lock that can be enabled or disabled, Martin never describes the operation of such a lock in response to the attachment of a portable safe to another device, such as a game-related device or a currency control device. The assertion to the contrary at page 8 of the Office Action is incorrect. According to the Examiner, a passage at column 9 of Martin provides a basis for this rejection because it mentions that the gate may be controlled to open or close “for a number of purposes”. Examples of such “purposes” are described in Martin (but not in the Official Action) and they include the presence of a jam of coins, or the presence of a collection of coins in the trommel or in the coin pick-up assembly. None of these elements relates to detaching of any part of a Martin coin mechanism from any other structure, as in the invention, or the consequence of closing of any gate. The passage of Martin does not support the proposition for which it was cited. Thus, at least two important features of claim 16 are entirely missing from Martin, assuming that Martin can even be considered analogous art that could be applied in an obviousness rejection. Those features are multiple window sections and respective locking shutter plates, and actuation of a lock upon attachment of two separately functioning units. Without those features being present somewhere in the references applied in rejecting claims 16, 21, and 22, *prima facie* obviousness has not been demonstrated. For this additional reason, claims 16, 21, and 22 should be allowed.

Conclusion

In summary, every claim now pending is clearly patentable over the prior art cited and applied in this patent application, both to the extent applied and to the extent the art is analogous. No pending claim can be anticipated by Heidel because of the absence from Heidel of at least two features (remote locations and transportation of currency between the remote locations) of each of the pending independent claims. No claim can be obvious in view of any combination of references including Kaish or Martin because neither of those publications is analogous art that is available for rejecting any pending claim as obvious. No claim depending from claim 1 can be obvious based upon any present rejection because those obviousness rejections all depend upon the anticipation of claim 1 by Heidel, an erroneous rejection. Claims 16, 21, and 22 cannot be obvious over the purported combination of publications, even if Kaish and Martin were

analogous prior art, because no combination of those publications includes all of the elements of claims 16, 21, or 22.


Request for Personal Interview

In view of the difficulties in understanding the two Office Actions that have been issued in this patent application, Applicant respectfully requests the Examiner contact his Washington-based representative, upon taking up this response, to schedule a personal interview. The agenda for the requested interview is as follows.

1. Clarification of the rejection of claim 16, i.e., whether claim 16 is rejected as anticipated, as obvious or both, and whether claims 17-20 are rejected as anticipated or as obvious.
2. Explanation of the specific obviousness rejections made with regard to the claims so rejected, in terms of what combinations of publications are applied in rejecting which claims.
3. Discussion of how Kaish and Martin could be considered analogous art to the claimed invention.

Prompt and favorable consideration of the amendments and arguments presented and provision of a personal interview, and allowance of all claims are earnestly solicited.

Respectfully submitted,


Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

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